

REMARKS

This Response is submitted in reply to the Office Action dated March 18, 2008. Claims 1, 11 to 13, 15, 22, 23, 27, 31, 34, 49 to 51, 53, 61, 65 and 72 to 74 have been amended. Claims 5 and 43 stand cancelled. No new matter has been added by these amendments. A Supplemental Information Disclosure Statement is submitted herewith. Please charge deposit account number 02-1818 for the cost of this Supplemental Information Disclosure Statement and any fees associated with this Response.

The Office Action rejected Claims 1 to 4, 6 to 11, 14 to 17, 19, 20, 22 to 42, 44 to 49, 52 to 56, 58 to 72 and 75 to 81 under 35 U.S.C. §103(a) as being unpatentable over "Slot Machines: A Pictorial History of the First 100 Years", Fifth Edition, by Marshall Fey ("Fey") in view of U.S. Patent No. 5,980,384 to Barrie.

Fey discloses draw poker dice games. Specifically, pages 74 and 75 of Fey discloses:

Dice games were popular since the advent of slots. This MIDGET series paid off over the counter on the combinations of six dice.

Player appeal and earnings were enhanced by the "second chance feature" on the original draw poker dice game. Wins on the first toss were awarded bonus pays, which were verified by the red flag located to the right of the dice. In a no win situation, the player had the option of saving any or none of the dice by depressing the corresponding "hold" lever in front of each die. He then flipped the dice not held a second times in hopes of improving the hand.

Barrie discloses a primary game and a secondary game that are dynamically linked. The primary game can be won independently of the secondary game. The primary game of Barrie may be won on each play of the game, and the secondary game may be won over a plurality of plays of the primary game. Primary game symbols appearing during plays of the primary game may cause: (i) movement of primary game symbols to secondary game display positions; (ii) primary game symbols directing play options of secondary game symbols; (iii) changing the options open to the player in his or her attempt to win the secondary game; (iv) symbols in the primary game being used as soft buttons to affect movement of game symbols from the primary game to the secondary game, and between symbol display positions in the secondary game; and (v)

secondary game symbols persisting to subsequent plays of the primary game to help the player to win at the secondary game.

Independent Claim 1 includes, amongst other elements, at least one processor programmed to operate with the at least one input device and the display device to display a play of the primary game upon a wager by a player, wherein if an outcome generated for the play of the primary game is a winning outcome, an award associated with the generated outcome is displayed and wherein the play of the primary game provides at least one of the gaming elements for the secondary game regardless of any event in the primary game and regardless of any generated outcome of the primary game and determine whether to display and provide the winning outcome in the secondary game, wherein the determination is based upon the plurality of gaming elements provided for playing the primary game a plurality of times.

The Office Action stated that a:

gaming element is interpreted as any element used in the game. For example, a gaming elements such as a die (or a given symbol) is used in both primary and secondary games. The initial toss is a primary game. Regardless of any event and regardless of any generated outcome of the initial toss, the "second chance feature" permits the player to save any or none of the dice and receive another poker hand. This subsequent poker hand is the secondary game.

The Office concluded that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to incorporate [into Fey] such electronic elements [from Barrie], since it has been held that providing a mechanical or automatic means to replace manual activity which has accomplished the same result involves only routine skill in the art.

Applicant respectfully disagrees. As discussed during the telephone interview, Applicant submits that neither Fey or Barrie individually, nor the gaming device resulting from the combination of Fey and Barrie disclose that the play of the primary game provides at least one of the gaming elements for the secondary game regardless of any event in the primary game and regardless of any generated outcome of the primary game. In Fey, if at least one die from the initial toss is held for the second poker dice hand, then the gaming elements for the secondary game (i.e., the held die used for the second poker dice hand) are provided based on an event in the primary game (i.e., the

generation of dice on the initial toss) and the generated outcome of the primary game (i.e., the player's decision to hold certain die is based on the combination of dice generated on the initial toss). On the other hand, if none of the dice from the initial toss in Fey are held for the second poker dice hand, then the play of the primary game (i.e., the generation of dice on the initial toss) does not provide at least one of the gaming elements (i.e., the held die used for the second poker dice hand) for the secondary game. Moreover, in Barrie, the play of the primary game does not provide at least one of the gaming elements for the secondary game regardless of any event in the primary game and regardless of any generated outcome of the primary game because the movement of the primary game symbols to the secondary game display positions occurs based on the events of the primary game (i.e., which primary symbols are generated). As neither Fey nor Barrie individually disclose that the play of the primary game provides at least one of the gaming elements for the secondary game regardless of any event in the primary game and regardless of any generated outcome of the primary game, Applicant submits that the combination of Fey and Barrie does not disclose that the play of the primary game provides at least one of the gaming elements for the secondary game regardless of any event in the primary game and regardless of any generated outcome of the primary game. Moreover, it would not have been obvious to one of ordinary skill in the art to modify Fey and Barrie to result in such a gaming device without reasonably being construed as improper hindsight reconstruction. On the other hand, the gaming device of independent Claim 1 discloses that the play of the primary game provides at least one of the gaming elements for the secondary game regardless of any event in the primary game and regardless of any generated outcome of the primary game. For these reasons, Applicant respectfully submits that independent Claim 1 is patentably distinguished over Fey and Barrie and in condition for allowance.

Claims 2 to 4, 6 to 11, 14 to 17, 19, 20 and 37 to 39 depend directly or indirectly from independent Claim 1, are also allowable for the reasons given with respect to Claim 1, and because of the additional features recited in these claims.

Independent Claims 22, 31, 34 and 68 each include certain similar elements to independent Claim 1. For reasons similar to those discussed above with respect to independent Claim 1, independent Claims 22, 31, 34 and 68 (and dependent Claims 23

to 30, 32, 33, 35 to 42, 44 to 49, 52 to 56, 58 to 67, 69 to 72 and 75 to 81) are each patentably distinguished over Fey and Barrie and in condition for allowance.

The Office Action rejected Claims 12, 13, 18, 21, 50, 51, 57, 73 and 74 under 35 U.S.C. §103(a) as being unpatentable over Fey in view of Barrie and in further view of U.S. Patent No. 7,297,058 to Gomez et al. ("Gomez").


Gomez teaches wide-area progressive systems. The Office Action concluded that it would have been obvious to one of ordinary skill in the art to incorporate a wide area progressive system into the gaming machine taught by Fey in view of Barrie for the purpose of allowing simultaneous play for a large jackpot.

Applicant submits that regardless of whether or not it would have been obvious to one of ordinary skill in the art to incorporate a wide-area progressive system of Gomez into the gaming device taught by Fey in view of Barrie, the gaming device resulting from the combination of Fey, Barrie and Gomez does not disclose that the play of the primary game provides at least one of the gaming elements for the secondary game regardless of any event in the primary game and regardless of any generated outcome of the primary game. Moreover, it would not have been obvious to one of ordinary skill in the art to modify Fey, Barrie and Gomez to result in such a gaming device without reasonably being construed as improper hindsight reconstruction. On the other hand, the gaming devices of Claims 12, 13, 18 and 21, the methods of operating a gaming device of Claims 50, 51 and 57 and the methods of operating a gaming system of Claims 73 and 74 each disclose that the play of the primary game provides at least one of the gaming elements for the secondary game regardless of any event in the primary game and regardless of any generated outcome of the primary game. For these reasons, Applicant respectfully submits that Claims 12, 13, 18, 21, 50, 51, 57, 73 and 74 are patentably distinguished over Fey, Barrie and Gomez and in condition for allowance.

An earnest endeavor has been made to place this application in condition for formal allowance and in the absence of more pertinent art such action is courteously solicited. If the Examiner has any questions regarding this Response, Applicant respectfully requests that the Examiner contact the undersigned.

Respectfully submitted,

BELL, BOYD & LLOYD LLP

BY 

Adam H. Masia
Reg. No. 35,602
Customer No. 29159

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